



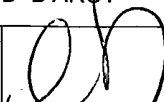
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/839,082	04/20/2001	David D'Arcy Clifford	T8466709US	2707
26912	7590	08/03/2004	EXAMINER	
GOWLING LAFLEUR HENDERSON LLP COMMERCE COURT WEST, SUITE 4900 TORONTO, ON M5L 1J3 CANADA			AFTERGUT, JEFF H	
			ART UNIT	PAPER NUMBER
			1733	

DATE MAILED: 08/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/839,082	CLIFFORD, DAVID D'ARCY	
	Examiner	Art Unit	
	Jeff H. Aftergut	1733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The applicant has amended claim 1 to recite “drawing inward the periphery of said stack from a first position to a second position by applying a uniform pressure to the stack with said die press”, see lines 8-9 of claim 1. While the applicant did disclose the use of a die press as depicted in Figures 2-4 where uniformity of pressure application was described, there is no support for the language “drawing inward” in the original disclosure. Additionally, it is not clear what was meant by drawing inward the periphery of said stack as the Figures do not depict in a reasonable manner the shifting of the periphery of the stack in the inward drawing of the same. Additionally, applicant appears to suggest that “drawing inward” precludes the used of holding the material on the edges. While the Figures do not show such a holding means, such is commonplace with conventional die presses. Additionally, “drawing” in the art was recognized as stretching and ort tensioning and as such, one would have expected that the material was thinned in the drawing inward operation. As applicant has argued that “drawing inward from the periphery” should be taken to mean that there is no mechanism which retains the edges of the

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stack in the forming operation. Because applicant did not describe in the specification as originally filed what was meant by “drawing inward the periphery of said stack from a first position to a second position by applying uniform pressure to said stack with said die press”, it is not at all clear what applicant intended for such language to mean. It should be noted that the language “drawing inward from the periphery has a much broader interpretation in a general sense than that taken by applicant and would include other processing other than that which applicant attempts to embellish upon it.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The applicant has amended claim 1 to recite “drawing inward the periphery of said stack from a first position to a second position by applying a uniform pressure to the stack with said die press”, see lines 8-9 of claim 1. The applicant in the response has tried to attribute certain properties to the “drawing inward the periphery of said stack” which are not described in the specification and it is unclear exactly what the scope of the language “drawing inward from the periphery” is in light of the arguments presented by applicant. It should be noted that “drawing inward from the periphery of said stack from a first position to a second position by applying a uniform pressure to said stack with said die press” means nothing more than using a die press which applied uniform pressure to the assembly to shape the same wherein a male member was pressed into a female mold to shape the material in the stack.

Claim Rejections - 35 USC § 103

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
6. Claims 1-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clifford or PCT WO 00/48831 and any one of Japanese Patent 11-151530, Japanese Patent 11-347642 or Onat et al optionally further taken with either one of Japanese Patent 58-252216 or Kojima et al for the same reasons as presented in paragraph 2 of the Office action dated 11-25-03.
7. Claims 1-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as set forth above in paragraph 6 further taken with Hook et al (newly cited) or Hirota et al (newly cited).

While the references as set forth above in paragraph 6 are believed to suggest the drawing inward as defined in the specification, to further evidence that one skilled in the art at the time the invention was made would have understood that such was taking place in the die pressing operation as set out above in paragraph 6, the references to Hook and Hirota are cited. Hook suggested that conventional die pressing operations with metal would have resulted in the periphery of the blank being drawn inward, see column 1, lines 42-50 for example. The reference to Hirota (who holds the blank during the forming operation in the die, clearly depicted the drawing of the blank inward as see in Figures 4 and 5. It would have been obvious to one of ordinary skill in the art at the time the invention was made that during the die press forming operation of the references as set forth above in paragraph 6 inward drawing would have taken place as evidenced by either one of Hirota et al or Hook et al in the manufacture of the automobile part.

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Double Patenting

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 1-22 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-23 of U.S. Patent No. 6,419,774 in view of either one of Clifford or PCT WO 00/48831 for the same reasons as presented in paragraph 4 of the Office action dated 11-25-03.

10. The terminal disclaimer submitted on May 25, 2004 has NOT been accepted. An attorney or agent, not of record, is not authorized to sign a terminal disclaimer in the capacity as an attorney or agent acting in a representative capacity as provided by 37 CFR 1.34 (a). See 37 CFR 1.321(b) and/or (c).

Response to Arguments

11. Applicant's arguments with respect to claims 1-22 have been considered but are moot in view of the new ground(s) of rejection.

The applicant argues that the drawing inward of the stack of material is different from that which was suggested in the prior art of record. More significantly, the applicant argues that the drawing inward somehow excludes the use of any kind of holding means to retain the blank

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along the edges in the molding operation. The applicant is advised that the language presented in regard to the drawing inward is new matter as addressed above. Additionally, the use of the language clearly does not exclude the use of a retaining means (as the reference to Hirota suggested).

The applicant is advised that the reference to PCT '831 is available as prior art under 35 USC 102(a) in the 103 rejection. It was a printed publication with a date which was before the filing date of this application. Additionally, it is agreed that the references to Clifford or PCT '831 did not suggest the specific pressing operation, however the secondary references clearly envisioned that in the manufacture of a panel for an automobile one skilled in the art at the time the invention was made would have been led to shape the material in the manner recited in a press die molding operation. As the references to Clifford and PCT '831 suggested that their laminates were alternatives to simply using a melt sheet of material, it would have been obvious to utilize the same in the operation of the secondary references to achieve none but the expected benefit of reduction in cost and improvements in strength in the finished assembly.

Regarding the reference to Japanese Patent '530, applicant is advised that the reference did expressly utilize a die molding operation wherein there was no blank holding means for retaining the periphery in the molding operation. As such, it is believed that the blank must be drawn inward during the molding operation out of the planar condition. Regarding the reference to Japanese Patent '642, the applicant argues that the edges were held and therefore there was a thinning of the material as the peripheral portions were locked in place. However, applicant is advised that the claims do not exclude the use of a retaining means for holding the edges. Additionally, the thinning of the material along the periphery during the shaping step is in fact

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drawing the sheet inward as noted above (drawing inward included stretching the material at the inner portion thereof wherein the material was thinned). The applicant is advised that the claims at hand are not commensurate in scope with the arguments as there is no exclusion of the edges (nor does it appear that applicant has support to claim the same). regarding Onat, again the applicant argues that the edges are locked in place during the draw in of the sheet. Applicant is advised that "drawing inward" as claimed is given its broadest reasonable interpretation (as applicant in their own specification did not define what was meant by the same) and therefore the processing of Onat is believed to be an inward drawing operation. As evidenced by Hirota (newly cited) one skilled in the art at the time the invention was made would have understood that retaining the edges did not preclude some degree of inward draw of the edge of the material in the operation.

The terminal disclaimer has not been accepted as it was not signed by an attorney or agent of record. The double patenting rejection is therefore being maintained.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeff H. Aftergut whose telephone number is 571-272-1212. The examiner can normally be reached on Monday-Friday 7:15-345 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Blaine Copenheaver can be reached on 571-272-1156. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jeff H. Altermatt
Primary Examiner
Art Unit 1733

JHA
July 30, 2004